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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,174	08/29/2000	Robert A. Cordery	F-189	9744

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EXAMINER

HAYES, JOHN W

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/650,174

Applicant(s)

CORDERY ET AL.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> . | 6) <input type="checkbox"/> Other: _____.                                   |

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## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 14 March 2003 have been fully considered but they are not persuasive.

Applicant asserts that there is no disclosure, teaching or suggestion is Kuzma of signed digital messages or validating a signed digital message. Examiner agrees with this assertion, however, examiner has not relied upon Kuzma for this teaching, but rather the reference to Fischer teaches this aspect in accordance with the rejection below.

Applicant further submits that it would not have been obvious to combine the teachings of Fischer and Kuzma to arrive at the present invention and further notes that the combination would simply teach a method and system to pay a transmission service for the electronic transmission of the digital message created and signed by the trusted authority. In response to this argument by the applicant, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Examiner submits that Fischer discloses validating signed digital messages received by a sender using the public key of the sender as is notoriously well known in the art. Fischer, however, does not disclose using a register with funds stored therein and deducting funds from the register for validating the message. Examiner then relied upon Kuzma to provide the missing features of Fischer. Kuzma discloses a method and apparatus for transmitting electronic data using attached electronic credits to pay

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for the transmission. Kuzma teaches the use of a register having funds stored therein, determining if sufficient funds are available in the register for validating a message, and deducting funds from the register for validating the message. Thus, Kuzma teaches the concept of using a register having funds stored therein to pay for a service such as validating a message to ensure legitimacy. Examiner submits that there is motivation for combining these references since both references teach the feature of performing a service and Kuzma further teaches a method of using a register having funds therein to pay for the service. The motivation would be to guarantee payment to the entity providing the service of validating the message (see Kuzma, Col. 8, lines 59-65).

***Terminal Disclaimer***

2. The terminal disclaimer filed on 14 March 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,134,328 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer, U.S. Patent No. 4,868,877 in view of Kuzma, U.S. Patent No. 5,771,289.

As per **Claim 35**, Fischer discloses a method for validating a signed digital message, comprising the steps of receiving a signed digital message from a sender and validating the signed digital message using a public key of the sender (Col. 3, lines 22-35; Col. 6, lines 34-45; Col. 7, lines 5-30 and 60-67).

Fischer, however, fails to explicitly disclose providing a register having funds stored therein, determining if

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sufficient funds are present in the register for validating the message and deducting funds from the register for validating the message. Kuzma discloses a method and apparatus for transmitting electronic data using attached electronic credits to pay for the transmission. Kuzma teaches the use of a register having funds stored therein, determining if sufficient funds are available in the register for validating a message, and deducting funds from the register for validating the message (Col. 5, lines 23-44; Col. 5 line 63-Col. 6 line 5; Col. 7, lines 40-45; Col. 7 line 63-Col. 8 line 9). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Fischer and include determining if sufficient funds are available for processing the validation and charging the consumer or deducting funds. The motivation would be to guarantee payment to the entity providing the service of validating the message (see Kuzma, Col. 8, lines 59-65).

As per **Claim 36**, Fischer further discloses receiving with the signed digital message a certificate of the sender, the certificate being signed using a private key of the certificate authority (Col. 3, lines 21-34, Col. 7, lines 5-29 and 60-67), validating the certificate using a public key of the certificate authority (Col. 7, lines 30-67), and extracting the public key of the sender from the certificate for use in validating the signed digital message (Col. 3, lines 21-34; Col. 6, lines 34-43; Col. 7, lines 5-30) which is a process well known in the encryption and digital signature arts.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Weiant, Jr. et al disclose a certificate meter and an accounting register wherein digital signatures are attached to a message and wherein there is an accounting for a service charge associated with each use of the certificate meter and to ensure that upon receipt of a message the recipient can verify that the message is genuine and signed by the sender and the message has not been altered.
- Lee et al disclose a method for using a smart card to gain access upon payment of a value and teach authenticating the existence of funds to pay for a transaction.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

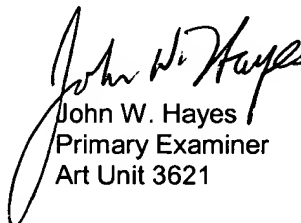
***Commissioner of Patents and Trademarks  
Washington D.C. 20231***

or faxed to:

**(703)305-7687** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703) 746-5531** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,  
VA, 7<sup>th</sup> floor receptionist.

  
John W. Hayes  
Primary Examiner  
Art Unit 3621

April 30, 2003